

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in a thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743,745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999); M.P.E.P. § 2112.IV., p. 2100-57, Rev 3, August 2005.

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); M.P.E.P. § 2112.IV., p. 2100-57, Rev. 3, August 2005.

Claim 1 recites "said exterior surface of said clip between said clip aperture and said leading edge dimensioned to create a low air pressure area immediately adjacent to said clip aperture when moving air travels over said leading edge."

The Examiner states: "Applicant's disclosure doesn't provide data to support what would be considered 'dimension to create a low pressure area.'" Applicant respectfully disagrees. At page 7, lines 17-23, applicant teaches,

In the currently disclosed device, this venting from the eye cavity from the side aperture is aided by a leading edge of the two sides of the goggle body being curved much like an airplane wing and creates lift and a resulting low pressure area immediately adjacent to the side venting apertures adjacent to clip apertures communicating through the clip, to draw air out through the side venting apertures.

Furthermore, at page 1, beginning at line 21, through page 2, line 5, the application teaches the following:

An aperture formed in the clip between the strap and body engagement creates the negative pressure adjacent to the side aperture of the goggle body. Further, by engaging the clip to the goggle in a hinged or rotational attachment allows for rotation of the clip and aperture toward and away from the goggle. This provides for increased air flow over the aerodynamic surface of the leading edge of the clip and provides increased

negative air pressure external to a side vent in the body when the goggle is being worn with or without a helmet.

Accordingly, the application does provide the disclosure necessary to enable a person of ordinary skill in the art to create a structure that would produce a low air pressure area adjacent to the side venting aperture.

In rejecting Claim 1, the Examiner states: "the areas of the claimed invention and the prior art reference are substantially the same size, and the structure of the inventions meets the limitations claimed by the applicant, it can be assumed that the prior art reference would perform in the same manner as that claimed by the applicant." Applicant respectfully disagrees with the Examiner.

In relying on inherency, the Examiner must provide a basis in fact and/or technical reasoning. Inherency may not be established by probabilities or possibilities. The Examiner states that the areas of the claimed invention and the prior art reference are substantially the same size. However, applicant submits this is not a scientific reason for concluding that the prior art reference performs in the same manner as that claimed by the applicant.

The Examiner also states that "a statement regarding the intended use of the invention has no patentable weight." Applicant respectfully disagrees. The Examiner is concluding various claim limitations are inherent in Desimone et al. In order for inherency to apply, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present. The Examiner concludes it is present, namely, by relying on the size of the respective devices being similar. Extrinsic evidence also indicates that the goggles of Desimone et al are designed for work involving either a welder or a chipper. (See Col. 2, lines 29-37.) The fact that Desimone et al explicitly teaches the use of the goggles is for a welder or chipper is objective evidence that is relevant to the issue whether the missing descriptive matter is missing. If the goggles are designed to be used for welding or chipping, then, the likelihood that the goggles meet all the limitations of Claim 1 is less probable.

Furthermore, the claimed structure and the structure of the Desimone et al. patent are not similar. Claim 1 requires a clip aperture communicating through said clip between said interior surface and said exterior surface. The Desimone et al. patent teaches that a button 17 is inserted to cut off any light through the opening, as shown in Figures 1 and 2. Other times the opening is covered with a wire screen button 17 as shown in Figures 5 and 6. (See Col. 2, lines 29-43.)

Accordingly, the Examiner's opinion that the structure of the Desimone et al. patent meets both structural and functional limitations is incorrect.

Accordingly, the withdrawal of the rejection of Claims 1, 2, 5, 13, and 14 is respectfully requested.

The Allowance of Claims 3, 4, 6-12

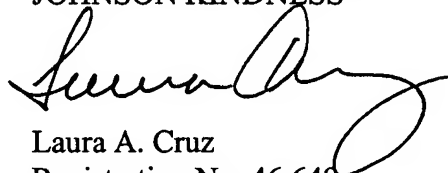
The indication of the allowance of Claims 3, 4, 6-12, other than being dependent upon a rejected base claim, is gratefully acknowledged.

CONCLUSION

In view of the foregoing remarks, applicant respectfully submits that Claims 1-14 are in condition for allowance. If the Examiner has any further questions or comments, the Examiner may contact the applicant's attorney at the number provided below.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: June 27, 2006
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